

II. REMARKS

Applicant offers the following remarks in response to the Final Office Action dated March 3, 2009.

A. STATUS SUMMARY

Claims 58 and 59 are pending in the present application. No claims have been cancelled. Claims 60 and 61 have been added. Accordingly, claims 58-61 are pending.

In this Amendment, Applicant has amended claims 58 and 59. Applicant is not conceding that the subject matter encompassed by claims 58 and 59 prior to this Amendment is not patentable over the art cited by the Examiner. Claims 58 and 59 were amended solely to facilitate expeditious prosecution of the present application. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by claims 58 and 59 as presented prior to this Amendment and additional claims in one or more continuing applications.

B. CLAIM OBJECTIONS

Claims 58 and 59 were objected to due to informalities. Applicant has amended claims 58 and 59 to correct antecedent basis and for general clarity. No new matter is believed added. Applicant believes that it has provided sufficient amendments to overcome the objections to claims 58 and 59. Applicant notes that the Final Office Action dated March 3, 2009, indicates that “[i]t seems that the user inputs are user selections.” (See Final Office Action dated March 3, 2009 page 3). However, the Specification and claims as originally filed make clear that the user may enter settings and may set and configure certain characteristics for certain elements of the present subject matter. (See Specification, paras. 0039, 0051, and 0053-0055; and claims 40 and

41 as originally filed). As such, it is believed that the term “user inputs” is an appropriate phrase for use within claims 58 and 59. All other considerations associated with the claim objections are believed addressed within the amendments to claims 58 and 59. Applicant respectfully requests that the claim objections be withdrawn.

C. CLAIM REJECTIONS – 35 U.S.C. § 112

Claims 58 and 59 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully traverses this rejection.

However, Applicant has amended claims 58 and 59 to clarify the subject matter of claims 58 and 59 as suggested. Therefore, Applicant respectfully requests that the rejections under 35 U.S.C. § 112, first paragraph, be withdrawn.

D. CLAIM REJECTIONS – 35 U.S.C. § 103

Claims 58 and 59 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,154,757 to Krause et al. (hereinafter “Krause”), in view of U.S. Patent Application Publication No. 2003/0122863 to Dieberger et al. (hereinafter “Dieberger”), further in view of U.S. Patent Application Publication No. 2001/0033296 to Fullerton et al. (hereinafter “Fullerton”), and further in view of Microsoft PowerPoint 2000 non-patent literature (screen printout pages 1-14 demonstrating a step by step guide showing some of the features of PowerPoint 2000) (hereinafter “Microsoft PowerPoint 2000”). Applicant respectfully traverses.

Prior to addressing the merits of the present rejection, Applicant offers the following brief summary of certain example embodiments consistent with the present subject matter as claimed in order to provide context for the arguments that follow, without intent to limit any claim’s

scope. Applicant has devised a way to add an intelligent agenda to a set of slides in a slide presentation program. The intelligent agenda is created, for example, by accessing titles from the set of slides to create an outline. The outline is adapted to be displayed in a corner on each slide of the set of slides. As such, a presenter is provided with a configurable intelligent agenda for a slide presentation that displays an outline in a corner on each slide in the slide presentation.

In contrast, the Krause reference is directed to a text reading enhancement method. The Krause reference discloses allowing a user to optimize reading speed. (See Krause, Abstract). The Krause reference makes clear that certain of its objects are to enable a reader to maximize reading speed, overcoming or mitigating reading disabilities, and teaching reading skills to beginning and intermediate readers. (See Krause, col. 3, lines 53-57, and col. 4, lines 11-12). The Krause reference satisfies these objectives by providing an unobstructed view of the subject text within a text box 405 and provides an outline associated with the text in a separate outline block 413 that is not “on” the text box 405. As such, a reader may view a selection of text and read that text without the outline block 413 obstructing the text box 405. Applicant finds no teaching or suggestion within the Krause reference of the outline block 413 being placed “on” the text box 405.

Applicant respectfully submits that any modification to display any obstruction “on” the text box 405 of the Krause reference would render the Krause reference unsatisfactory for its intended and expressly stated purposes. Additionally, any such modification would change the principle of operation of the Krause reference. As such, in contrast to allegations of the Patent Office, Applicant respectfully submits that the Dieberger reference cannot be combined with the

Krause reference without destroying the functionality and utility of the Krause reference. Additionally, the Krause reference teaches away from any such modification at least by many of its stated objectives.

For the Patent Office to combine references in an obviousness rejection, the Patent Office must first establish *prima facie* obviousness by showing where each and every element is taught or suggested in the combined references. MPEP § 2143.03. This is a fundamental to an analysis under the factual inquiries required by *Graham v. John Deere*, 383 U.S. 1 (Supreme Court, 1966), as a part of identification of the scope and content of the prior art. The Patent Office has failed to do so in the present rejection. At least one element is missing from the combination of references and the Patent Office has failed to provide any articulated reasoning as to why one of ordinary skill in the art would find the claims as a whole to be obvious in the absence of the claim features not present in the prior art. (See *In re Kahn*, 441 F.3d 977, 988 (CAFC, 2006), as explicitly endorsed by the Supreme Court). Such an analysis is required in order to satisfy the factual inquiry ascertaining the differences between the prior art and the claims at issue. Accordingly, the Patent Office has failed to establish *prima facie* obviousness and the present rejection should be withdrawn.

As a preliminary matter, the Patent Office alleges that the Krause reference may be combined with the Dieberger reference to render Applicant's claimed subject matter obvious. (See Final Office Action dated March 3, 2009, page 7). However, Applicant has reviewed the cited portions of the Krause reference and the Dieberger reference and respectfully submits that any attempt to modify the Krause reference to place the outline of the Dieberger reference on the

text box 405 of the Krause reference would render the Krause reference unsatisfactory for its intended purpose, change a fundamental principle of operation of the Krause reference, and thereby destroy the functionality and utility of the Krause reference.

“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” (MPEP § 2143.01, VI citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). “If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” (MPEP § 2143.01, V citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), emphasis added).

The Krause reference makes clear that certain of its objectives are to enable a reader to maximize reading speed, overcoming or mitigating reading disabilities, and teaching reading skills to beginning and intermediate readers. (See Krause, col. 3, lines 53-57, and col. 4, lines 11-12). Applicant respectfully submits that placing an obstruction on the text box 405 of the Krause reference would require text within the text box to be rearranged to accommodate the obstructing outline.

Applicant believes that such rearrangement of text within the text box 405 may interfere with a reader's reading speed at least because the reader would have to adjust reading tempo for varying line lengths or for shorter lines depending upon the extent of the intrusion into the text box 405. Additionally, rearrangement of text within the text box 405 may challenge persons with reading disabilities and may not help them to overcome or mitigate their reading

disabilities. Further, rearrangement of text within the text box 405 may make it more difficult to teach reading skills to beginning and intermediate readers.

As such, for at least these reasons Applicant respectfully submits that the Krause reference may not be combined with the Dieberger reference as alleged by the Patent Office without rendering the Krause reference unsatisfactory for its intended purpose and without changing a fundamental principle of operation of the Krause reference. Such modifications would destroy the functionality and utility of the Krause reference. In fact, for at least these reasons, Applicant believes that the Krause reference may not be combined with any reference that places any obstruction on the text box 405.

Based upon these and additional distinctions, as discussed in more detail below, there is no suggestion or motivation to make the Patent Office's proposed modifications of the Krause reference. Further, any combination of the references, as cited, is not sufficient to render Applicant's claims *prima facie* obvious at least because any such modification would render at least the Krause reference unsatisfactory for its intended purposes and would change a fundamental principle of operation of the Krause reference.

As such, the Patent Office's factual allegations regarding combination of the cited references are believed to be in error. Further, the Patent Office's legal allegation and conclusion of obviousness is also believed to be in error as at least being based upon erroneous factual allegations. Accordingly, Applicant respectfully submits that the rejection of the present claims should be withdrawn for at least these reasons.

With the discussion above as a foundation, Applicant respectfully submits that the majority of the Patent Office's allegations regarding the disclosure of the Krause reference are directed to subject matter that may not be properly combined by the Patent Office. However, Applicant provides the following discussion regarding additional deficiencies of the Final Office Action dated March 3, 2009, to further assist the Patent Office in determining that the present rejections should be withdrawn.

Applicant has further amended claim 58 to clarify that the presentation program is a slide presentation program. Support for the amendments may be found within paragraph [0031], as follows: "[a]s used herein, the term "presentation program" shall mean a computer program for displaying a slide show." As such, Applicant believes that no new matter has been added.

Regarding the rejection of claim 58, claim 58 recites, among other things, "responsive to a user invoking an options menu on the slide presentation program and selecting an intelligent agenda option on the options menu" The Patent Office alleges that elements of this phrase of claim 58 are disclosed within the Krause reference. (See Final Office Action dated March 3, 2009, page 5). However, Applicant has studied the cited portion of the Krause reference and believes that the Krause reference does not teach or suggest selecting an intelligent agenda option on the options menu in response to a user invoking an options menu on a slide presentation program, as claimed.

First, because the Krause reference is not directed to a slide presentation program, the Patent Office's allegation that the Krause reference discloses that certain actions occur responsive to a user invoking an options menu on the slide presentation program is in error. The

Patent Office has not alleged that the Dieberger reference cures this deficiency. Applicant further believes that any combination with the Dieberger reference to attempt to cure this deficiency would also be in error, at least as discussed above.

Second, because the Krause reference is not directed to a slide presentation program and does not disclose an action responsive to a user invoking an options menu on a slide presentation program, as claimed, the Patent Office's allegation of selecting an intelligent agenda option on the claimed options menu (on the slide presentation program) is also in error. The Patent Office has not alleged that the Dieberger reference cures this deficiency. Applicant further believes that any combination with the Dieberger reference to attempt to cure this deficiency would also be in error, at least as discussed above.

Based upon this analysis, the factual disclosure of the cited portion of the Krause reference is different from that alleged by the Patent Office and distinct from Applicant's claimed subject matter. Accordingly, the Patent Office's allegations regarding the factual disclosure of the Krause reference are in error and the rejection of claim 58 should be withdrawn for at least these reasons. Additionally, the Patent Office's legal conclusion of obviousness is also in error as at least being based upon erroneous factual allegations.

Claim 58 also recites, among other things, "creating an intelligent agenda for the plurality of slides by accessing a plurality of titles from the plurality of slides in the slide presentation program to create an outline" The Patent Office alleges that the Krause reference discloses this claimed subject matter. (See Final Office Action dated March 3, 2009, pages 5-6). The Patent Office then admits that the Krause reference is directed to a "document" within the

rejection and attempts to use a secondary reference, the Dieberger reference, to attempt to fill this gap. However, as discussed above, the Dieberger reference cannot be properly combined with the Krause reference without at least rendering the Krause reference unsatisfactory for its intended purpose and without changing a fundamental principle of operation of the Krause reference. Further, at least because the Krause reference is admittedly directed to a “document,” it does not disclose creating an intelligent agenda for the plurality of slides by accessing a plurality of titles from the plurality of slides in the slide presentation program to create an outline, as claimed.

Based upon this analysis, the factual disclosure of the cited portion of the Krause reference is different from that alleged by the Patent Office and distinct from Applicant’s claimed subject matter. Further, the Krause reference is not properly combined with the Dieberger reference. Accordingly, the Patent Office’s allegations regarding the factual disclosure of the Krause reference are in error and the rejection of claim 58 should be withdrawn for at least these reasons. Additionally, the Patent Office’s legal conclusion of obviousness is also in error as at least being based upon erroneous factual allegations.

Claim 58 also recites, among other things, “adapting the outline to be displayed in a corner on each slide of the plurality of slides” The Patent Office alleges that this claimed subject matter is disclosed within the Krause reference and further alleges that the Krause subject matter discloses a “presentation.” (See Final Office Action dated March 3, 2009, page 6). However, as discussed above, claim 58 recites a slide presentation. Additionally, the Patent Office has admitted that the Krause reference is directed to a document. As such, the present

allegation contradicts the Patent Office's previous allegation and is an inconsistent application of the disclosure of the Krause reference. Accordingly, for at least this reason, the factual allegations of the Patent Office regarding the disclosure of the Krause reference are in error.

Additionally, Applicant has reviewed the cited portions of the Krause reference and finds that in each cited Figure, the outline of the Krause reference (that is associated with a document and not a slide presentation) is displayed within a separate window text box. Applicant respectfully submits that this disclosure is consistent with the stated objectives of the Krause reference discussed above and that this disclosure does not teach or suggest adapting the outline to be displayed in a corner "on" any other substantive portion of the Krause subject matter. Accordingly, for at least this additional reason, the factual allegations of the Patent Office regarding the disclosure of the Krause reference are in error.

Furthermore, Applicant respectfully submits that the outline of the Krause reference is not displayed "on" each slide of the plurality of slides, as claimed. Accordingly, for at least this additional reason, the factual allegations of the Patent Office regarding the disclosure of the Krause reference are in error.

Claim 58, further recites, among other things, "introducing a user configurable line to each slide of the plurality of slides, the user configurable line connecting to each of two contiguous border lines of each slide of the plurality of slides to define a corner section containing the outline on each slide of the plurality of slides" (as amended). The Patent Office admits that this claimed subject matter is not disclosed in any of the cited references, yet alleges that this claimed subject matter is well known in the art. (See Final Office Action dated

March 3, 2009, pages 6 and 8, respectively). The Patent Office then suggests that changing the term “on” to “of” in this claim section provides basis to distinguish one interpretation of a non-patent literature reference. (See Final Office Action dated March 3, 2009, page 8). Applicant respectfully disagrees, but has amended claim 58 to provide this clarification to expedite prosecution of the present application. Applicant respectfully submits that the rejection of claim 58 should be withdrawn for at least this additional reason.

Lastly, regarding the Patent Office’s reasoning for combination of the Krause reference with the Dieberger reference, the Patent Office alleges that an alternate display mode would “provide more viewing space for the presentation content, and easily display the contextual information in a non-intrusive manner.” (See Final Office Action dated March 3, 2009, page 7). However, Applicant believes this allegation is also in error.

As discussed in detail above, the intended purpose of Krause is to enhance a user’s reading experience. As such, the separate window of Krause provides an unobstructed view of the text. Modification of the Krause reference to place an outline over the text would render the Krause reference unsatisfactory for its intended purpose, change a fundamental principle of operation of the Krause reference, and would destroy the functionality and utility of the Krause reference. Accordingly, Applicant respectfully submits that the reasoning of the Patent Office in support of combination of the Krause reference with the Dieberger reference is in error.

Based upon this analysis, the factual disclosure of the cited portions of the Krause reference are different from the alleged disclosure and distinct from Applicant’s claimed subject matter. Additionally, the Krause reference is not properly combinable to arrive at Applicant’s

claimed subject matter. Further, the Patent Office's reasoning for combination is also believed to be in error. As such, the rejection of claim 58 should be withdrawn for at least these reasons. Additionally, the Patent Office's legal conclusion of obviousness is also in error as at least being based upon erroneous factual allegations and reasoning.

Accordingly, several elements of claim 58 have not been identified within the cited combination of references. Further, the Patent Office has not provided any articulated reasoning as to why a person of ordinary skill in the art would find the claims as a whole obvious in the absence of the claim features not present in the cited combination of references.

As such, the Final Office Action dated March 3, 2009, fails to identify multiple elements of claim 58 within the combination of the cited references. Additionally, the Final Office Action alleges multiple factual errors regarding the disclosure of the references as cited. Applicant respectfully submits that the Patent Office's legal conclusion of obviousness is also in error as at least being based upon erroneous factual allegations and reasoning. Accordingly, the Patent Office has failed to establish a *prima facie* case of obviousness and the rejection of claim 58 should be withdrawn for at least these reasons. Applicant reserves the right to provide additional arguments against the combination of the Krause reference with the Dieberger, Fullerton, or Microsoft PowerPoint 2000 references in the future if needed.

Claim 59 depends from claim 58. Accordingly, the rejection of claim 59 should be withdrawn for at least the same reasons as the independent claim from which it depends. Applicant respectfully submits that claims 58 and 59 are in condition for allowance and notice of the same is requested at the earliest possible date.

The undersigned additionally notes that many distinctions exist between the cited references and the claims. However, in view of the deficiencies discussed above, further discussion is believed to be unnecessary at this time. Failure to address each point raised in the Final Office Action should accordingly not be viewed as accession to the Examiner's position or an admission of any sort. In view of the above, reconsideration and allowance are respectfully requested.

E. NEW CLAIMS

Claims 60 and 61 have been added, and are believed to be fully supported by the application as originally filed. For example, claims 21 and 36-39 as originally filed provide support for the subject matter of claims 60 and 61. Accordingly, no new matter is believed to have been added. Applicant respectfully submits that new claims 60 and 61 are patentable over all references of record. Therefore, Applicant respectfully requests that new claims 60 and 61 be entered and allowed.

III. CONCLUSION

In light of the above Amendments and Remarks, it is respectfully submitted that the present application is now in proper condition for allowance, and an early notice to such effect is earnestly solicited.

If any small matter should remain outstanding after the Patent Examiner has had an opportunity to review the above Remarks, the Patent Examiner is respectfully requested to telephone the undersigned patent attorney in order to resolve these matters and avoid the issuance of another Office Action.

Though it is believed that the appropriate fees have been submitted herewith, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 09-0461.

Respectfully submitted,

Lee Law, PLLC

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